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10/06/2003

Butler, Snow, O'Mara, et. al.

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EXAMINER

ASHLEY, BOYER DOLINGER

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 10/06/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/001,403

Applicant(s)

GHARST, THOMAS

Examiner

Boyer D. Ashley

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Inventorship***

1. In view of the papers filed 10/29/02, it has been found that this nonprovisional application, as filed, through error and without deceptive intent, improperly set forth the inventorship, and accordingly, this application has been corrected in compliance with 37 CFR 1.48(b). The inventorship of this application has been changed by adding Jerry Cheek as a co-inventor.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of the file jacket and PTO PALM data to reflect the inventorship as corrected.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 5, the "can be" language on lines 2, 5, 10 and 12 is indefinite, e.g., in the phrase "... said insulation can be placed adjacent to said cutting groove" it is not clear if the insulation is placed adjacent to the cutting groove or not.

In claim 18, the "can" and "can be" language on lines 4, 5, 9, 12-13, 16, and 20 are indefinite, e.g., in the phrase "... said insulation can be placed adjacent to said

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cutting groove" it is not clear if the insulation is placed adjacent to the cutting groove or not.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-10, 14-17, and 22-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Keon et al., U.S. Patent 5,046,392.

Keon et al. discloses the same invention as claimed including, for example, a carrying means (18/30) for carrying and dispensing a roll of insulation; and a cutting and scoring means (28) for cutting a first portion of insulation and for scoring a second portion of insulation without cutting the backing layer of the insulation. See the abstract, column 3, lines 1-30, and column 7, lines 9-20.

As to claim 4, Keon et al. discloses a cutting means and a scoring means that are spatially fixed. See Figure 4.

As to claims 5-10, Keon et al. discloses a cutting means with a cutting groove (50) and a scoring means with a scoring path (42) that is substantially planar. See Figure 3.

As to claims 14-17, Keon et al. discloses the use of rotary/circular cutting and scoring blades. See Figures 3 and 4.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keon et al. in view of Dueck et al., U.S. Patent 4,809,921, or Gordon, U.S. Patent 2,598,992.

Keon et al. discloses the invention substantially as claimed except for the carrying means being a dolly. However, Dueck and Gordon disclose that it is old and well known in the art to use dollies with dispensing and cutting apparatus for the purpose of facilitating movement of the device of the device into a better dispensing position. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a dolly with the dispensing device of Keon et al. in order to facilitate placement of the device as well as to make the device portable. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the device of Keon et al. with a dolly for the purpose of facilitating placement of the device, because it has been held that making an old device portable or movable without producing any new and unexpected result involves only routine skill in the art.

As to claim 3, the modified device of Keon et al. discloses a carrying means comprising two handles that also function as feet (18, see Dueck et al.). In the alternative, the modified device of Keon et al. discloses the use of carrying means

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having a single handle (42, see Gordon) that also functions as a foot for support the device when lowered to the ground. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use two handles, one on each side of side bars (10, Gordon) instead of a single handle in the center for the purpose of providing a more stable support for dispensing when lowered as well as providing an easier mode of movement by allowing the user to use both hands during movement from one location to another, because it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

8. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keon et al.

Keon et al. discloses the invention substantially as claimed except for the specific distances between the scoring path and the cutting groove. In this case, 1.5 inches, 0 to ten inches, or 0 to 100 inches. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the specific distance or range of distances between the cutting and scoring blades in order to provide the required backing lay without insulation depending upon the specific type job or size of insulation needed, because it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

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***Allowable Subject Matter***

9. Claims 18-21 appear to be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boyer D. Ashley whose telephone number is 703-308-1845. The examiner can normally be reached on Monday-Thursday 7:30-6:00. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan N. Shoap can be reached on 703-308-1082. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.



Boyer D. Ashley  
Primary Examiner  
Art Unit 3724

BDA  
September 4, 2003